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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,594	10/29/2001	Stephen Y. Chou	600.426US2	3744

1688 7590 03/26/2008

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EXAMINER	
VARGOT, MATHIEU D	
ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
03/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/046,594	CHOU, STEPHEN Y.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,42-56 and 59-110* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,42-56 and 59-110* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 105, 106, 108 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Napoli et al for reasons of record.

2.Claims 1, 42-56, 59-104, 107 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Napoli et al in view of European Patent Application 244,844 for reasons of record.

3.The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.Claims 1, 42-56 and 59-110 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-46, 48-50 and 67-71 of U.S. Patent Application No. 10/244,276 for reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5.Claims 1, 42-56 and 59-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-65 of copending Application No. 10/244,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending application 10/244,296 set forth essentially the instant invention as set forth in the instant claims, with only minor differences in feature dimensions and nomenclature. It is submitted that these differences would have been clearly obvious over each other and well within the skill level of the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6.Claims 1, 42-56 and 59-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-13, 15-43 and 58-72 of copending Application No. 10/244,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending application 10/244,303 set forth essentially the instant invention as set forth in the instant claims, with only minor differences in feature

dimensions and nomenclature. It is submitted that these differences would have been clearly obvious over each other and well within the skill level of the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7.Claims 1, 42-56 and 59-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/932,772 in view of European Patent Application 244,884. The claims of copending application 11/932,772 and the instant claims set forth essentially similar methods involving the pressing into a moldable surface of a substrate a mold having a molding surface, wherein a pattern replicated has a feature with a minimum dimension of 200 nm or less. It is submitted that the exact dimensions of the features, the material of the moldable surface and that of the molding surface are well known and would have been obvious expedients in the process of 11/932,772. Further, the instant release agent with an inorganic linking group is taught in European -884 and its use in the process of -772 would have been obvious to facilitate release of the molded article.

This is a provisional obviousness-type double patenting rejection.

8.Claims 1, 42-56 and 59-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/932,924 in view of European Patent Application 244,884. The claims of copending application 11/932,924 and the instant claims set forth essentially similar methods involving the pressing into a moldable surface of a

substrate a mold having a molding surface, wherein a pattern replicated has a feature with a minimum dimension of 200 nm or less. It is submitted that the exact dimensions of the features, the material of the moldable surface and that of the molding surface are well known and would have been obvious expedients in the process of 11/932,924. Further, the instant release agent with an inorganic linking group is taught in European -884 and its use in the process of -924 would have been obvious to facilitate release of the molded article.

This is a provisional obviousness-type double patenting rejection.

8.Claims 1, 42-56 and 59-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/932,599 in view of European Patent Application 244,884. The claims of copending application 11/932,599 and the instant claims set forth essentially similar methods involving the pressing into a moldable surface of a substrate a mold having a molding surface, wherein a pattern replicated has a feature with a minimum dimension of 200 nm or less. It is submitted that the exact dimensions of the features, the material of the moldable surface and that of the molding surface are well known and would have been obvious expedients in the process of 11/932,599. Further, the instant release agent with an inorganic linking group is taught in European -884 and its use in the process of -599 would have been obvious to facilitate release of the molded article.

This is a provisional obviousness-type double patenting rejection.

9.Applicant's arguments filed January 10, 2008 have been fully considered but they are not persuasive. The amendment obviates the 112 rejection that had been made concerning claims 64-83. However, the art rejection has been maintained and the double patenting rejection(s) maintained as well as new ones being made with respect to later filed applications. Applicant submits that the instant features are "unimaginably small", presumably with respect to the features disclosed in Napoli et al. Most of the independent claims recite features down to 100-125-150 nm, and it is maintained that there is not a sufficient difference between this and the 700-600 nm dimensions taught in Napoli et al to warrant patentability. Also, it should be noted that independent claims 64 and 84 and most of their dependent claims **do not even recite a dimension**, so it is unclear to what extent applicant's comments concerning feature size can apply to these claims. Applicant goes on to discuss why Napoli et al cannot form features as small as 200 nm. At this point, it is respectfully submitted that these assertions constitute no more than attorney conjecture. There is no probative evidence that the process of Napoli et al cannot form features with dimensions down to the instant. While it is understood that people make inventions, it is respectfully submitted that modifying a reference that teaches 600-700 nm features to one that can make features down to 100 nm is prime facie obvious unless proven otherwise. While the examiner has stated that the passage of time would probably be a factor in being able to reach smaller dimensions, such is not really even the issue in this case. Regardless of the passage of time aspect, it is not clear on record that the instant claims would be patentable over the prior art. Clear evidence needs to be shown that Napoli et al cannot

reach the instant dimensions or the claims must be rejected as being prime facie obvious.

10.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 23, 2008

/Mathieu D. Vargot/
Primary Examiner, Art Unit 1791